



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/685,138

10/11/2000

Ju-Heon Lee

112-1001

4552

38209 7590 04/05/2007
STANZIONE & KIM, LLP
919 18TH STREET, N.W.
SUITE 440
WASHINGTON, DC 20006

EXAMINER

NGUYEN, TANH Q

ART UNIT

PAPER NUMBER

2182

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
|--|-----------|---------------|

3 MONTHS

04/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/685,138 | LEE, JU-HEON | |
| | Examiner | Art Unit | |
| | Tanh Q. Nguyen | 2182 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,21-28 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,21-28 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 38 recites "the cover has an overall interior opening of a thickness greater than the overall thickness of the flat ledge", and therefore cannot enable "the thickness of the retractable cover equals the overall thickness of the housing minus the overall thickness of the flat ledge", as recited in claim 41.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2,4-8, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over MachASP USB - Software Protection via the USB by Aladdin Knowledge System published October 1998 (hereinafter MachASP) in view of Liu (CN2032364U), and

further in view of Ban et al. (US 6,148,354).

5. As per claim 1, MacHASP teaches a portable memory device for a USB-supporting data processing system [MacHASP USB connects to the new industry-standard USB which is standard equipment on new generations Mac computers], the memory device comprising:

a USB connector [USB Type A connector] for being connected to a USB port of the data processing system [protects software via any available USB port; MacHASP USB connects to the new industry-standard USB which is standard equipment on new generations Mac computers];

an integrated circuit memory for writing/reading data [90 bytes or read/write memory].

MacHASP does not teach a connector cover protecting the USB connector from damage, the connector cover capable of sliding automatically backwards upon insertion of the portable memory device into the USB port exposing the USB connector.

Liu teaches an electrical plug having an electrical connector and a connector cover sliding automatically backward upon insertion of the electrical plug into an electrical socket and exposing the electrical connector - in order to protect the electrical connector.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a connector cover on the portable memory device, the connector cover sliding automatically backward upon insertion of the portable memory device into the USB port (as Liu would have suggested to one skilled in the art)

in order to protect the USB connector.

MachASP/Liu does not specifically teach a USB interface coupled between the USB connector and the memory - for interfacing the memory with the data processing system.

Ban teaches a USB interface [56, FIG. 5] coupled between a USB connector [52, FIG. 5] and a memory [58, FIG. 5] for interfacing the memory with a data processing system [44, FIG. 5].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a USB interface between the USB connector and the memory, as is taught by Ban, in order to interface the memory with the data processing system.

6. As per claims 2, 4-8, MachASP teaches the memory being a nonvolatile semiconductor memory [memory data retention at least 10 years];

the memory device being worked as a portable memory device of the data processing system [the 90 Bytes of read write memory are indicated as being used to save passwords, user or application specific information, and parts of your source code);

the memory device supporting a plug and play function, and the USB connector being capable of being connected and separated to/from the USB port of the data processing system while the data processing system is powered on [Hot swappable, and furthermore plug and play is a characteristic of USB devices];

the memory device storing a security information, the data processing system

Art Unit: 2182

storing a security information to verify an authorized user, the data processing system starting to work when the security information of the memory device is matched with the security information of the data processing system [the 90 Bytes of read write memory are indicated as being used to save passwords, user or application specific information; Each MachASP USB contains a unique code for each software developer, which is recognized by the protected software. During runtime, the protected application checks whether a MachASP USB with the correct code is connected to the computer's USB. If the MachASP USB code is confirmed, the application is executed. If not, the application will not run].

7. As per claims 21-23, Liu teaches the plug having the connector and the connector cover sliding automatically backward upon insertion of the plug into the socket and exposing the connector - hence backward being a direction that is opposite the direction of insertion of the plug into the socket; a spring coupled between the connector cover and a housing, the spring being biased to push the cover away from the housing to cover the connector when no pressure is applied to the spring, and the spring being compressed upon insertion of the plug into the socket [see drawing on front page] - hence in combination with MachASP teaches backward being a direction that is opposite the direction of insertion of the memory device into the USB port; a spring coupled between the connector cover and a housing of the memory device, the spring being biased to push the cover away from the housing to cover the connector when no pressure is applied to the spring, and the spring being compressed upon insertion of the portable memory device into the USB port.

Art Unit: 2182

8. As per claim 24, Liu teaches the cover having a ridge protruding from a side portion of the cover that engages a concave groove in a housing enabling the cover to slide forward and backward with respect to the housing [see drawing on front page]. Furthermore, a convex ridge and a concave groove are well known to be used as guides to allow a component to slide on another component, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such components in order to guide the cover and to allow the cover to slide with respect to the housing.

9. Claims 25-28, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,038,320) in view Crisan (US 6,292,890) and further in view of Liu (CN2032364U).

10. As per claims 25-28, Miller teaches a method of securing a host computer system [Fig. 6] having steps of applying power to the host computer (100), determining if a USB device 40 is connected to the computer (110), (if security is enabled) comparing security information (key code) in the host computer with that of the USB device and enable the hard disk drive (after the password entered by the user is verified) of the host computer if security information of the device matched with the security information store in the memory of the host computer [col. 4, lines. 51-62 and step 200]. Please note that connecting a device prior to power up, booting the host comprising loading an operating system are inherent during the power up and booting of the computer. Please further note the claim does not exclude the presence of the step of checking for the enablement of the security and matching of user's password.

Art Unit: 2182

Miller does not teach the step of displaying an error message if the USB device is not connected or the security information does not match. Crisan teaches that it is common for error to be displayed for error encountered during the boot up process [background: col. 1, line 46 to col. 2, line 22].

It would have been obvious to one having ordinary skill in the art to implement the teaching of displaying error message when an error is encountered during the boot up process, as is taught by Crisan, in order to inform the user of the status/progress of the boot up process.

Please note password is a sequence of characters (numbers, characters or a combination therefore) used to compare against a stored list of authorized codes and users. The key code of the security key 40 is therefore the password of the security key since it is used to compared against a stored code in the BIOS flash memory 24 [col. 3, lines 1-7].

Miller/Crisan does not teach said attaching step comprising automatically sliding a cover on said USB security device backward in a direction opposite to a direction of inserting the USB security device into the USB port when the USB security device is attached to the USB port of the host computer.

Liu teaches an electrical plug having an electrical connector and a connector cover sliding automatically backward upon insertion of the electrical plug into an electrical socket and exposing the electrical connector - in order to protect the electrical connector.

It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 2182

invention was made to incorporate a connector cover on the USB security device, the connector cover sliding automatically backward upon insertion of the USB security device into the USB port (as Liu would have suggested to one skilled in the art) in order to protect the USB connector.

11. As per claim 31, Miller teaches the USB security device comprising a USB connector [48, FIG. 3] for being connected to the USB port [31, FIG. 2] of the host computer [20, FIG. 2], an integrated circuit memory [46, FIG. 3] for writing/reading data, and a USB interface [42, FIG. 3] coupled between the USB connector and the memory, for interfacing the memory with the data processing system.

12. As per claim 32, the claim generally corresponds to claim 31 and is rejected on the same basis.

13. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacHASP in view of Liu and Ban et al., and further in view of Evidence I: USB Special - The Key to Software and Security by Aladdin Knowledge System published September 1998 (hereinafter Evidence I).

14. MacHASP teaches a portable memory device for a USB-supporting data processing system, the memory device comprising a USB connector to be connected to a USB port of the data processing system, and an integrated circuit memory to write/read data (see rejection of claim 1 above).

MacHASP does not teach an automatically retractable cover having a rectangular cross section to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system.

Liu teaches an automatically retractable cover to protect a connector of a plug from damage when the plug is not connected to a socket (see rejection of claim 1 above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate an automatically retractable cover on the portable memory device in order to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system, as Liu would have suggested to one skilled in the art.

Liu also teaches the automatically retractable cover having a circular cross section, and the plug having a circular shape - hence suggests to one skilled in the art to shape the automatically retractable cover in accordance with the shape of the plug.

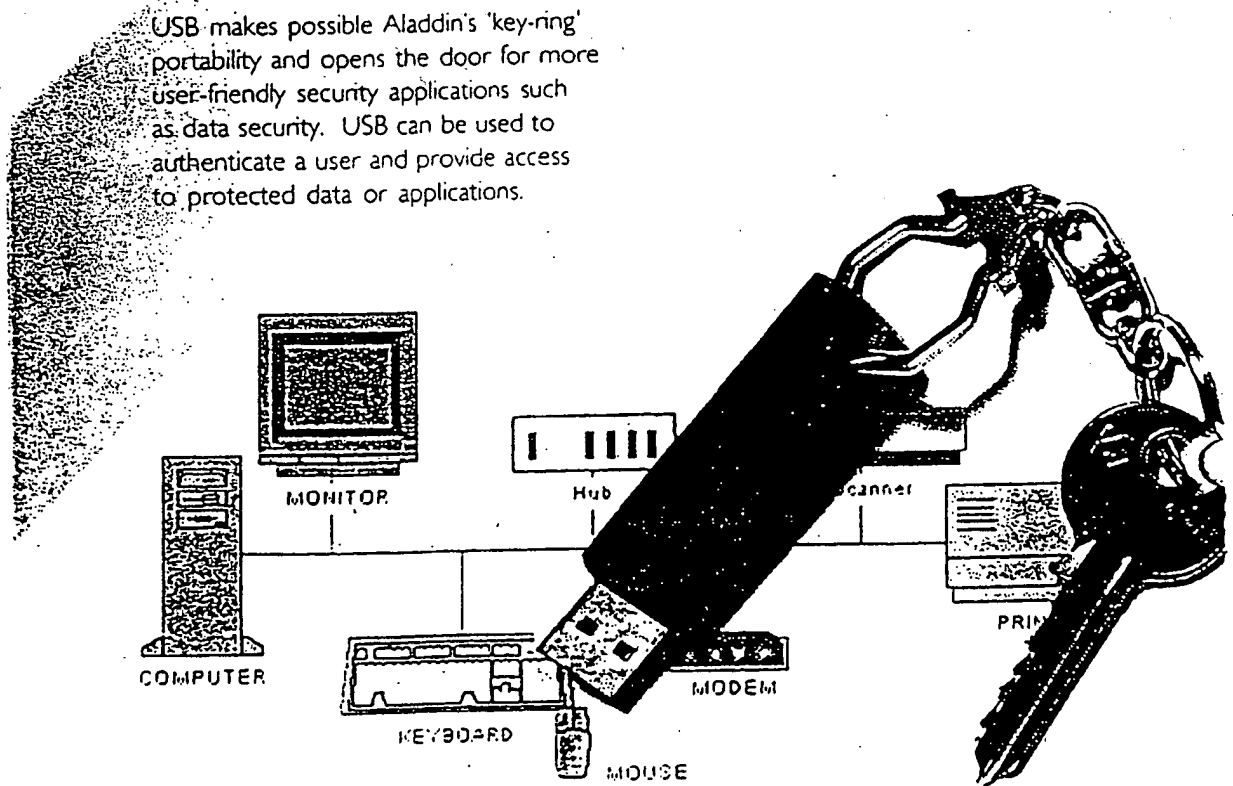
It would have been obvious to one of ordinary skill in the art at the time the invention was made for the automatically retractable cover to have a rectangular cross section because Liu would have suggested to one skilled in the art to shape the automatically retractable cover in accordance with the shape of the portable memory device and the portable memory device has a rectangular shape, and because a change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

MachASP does not specifically teach a USB interface coupled between the USB connector and the memory - for interfacing the memory with the data processing system. Ban teaches a USB interface [56, FIG. 5] coupled between a USB connector [52, FIG. 5] and a memory [58, FIG. 5] for interfacing the memory with a data

Art Unit: 2182

processing system [44, FIG. 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a USB interface between the USB connector and the memory, as is taught by Ban, in order to interface the memory with the data processing system.

MachASP does not teach the portable memory device comprising a hole to accommodate a key ring. Evidence I teaches a portable memory device comprising a hole to accommodate a key ring and make the portable memory device key-ring portable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to comprise a hole in order to accommodate a key ring and make the portable memory device key-ring portable.



Art Unit: 2182

15. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacHASP in view of Liu, Ban et al., Evidence I, and further in view of Powell et al. (US 5,599,196).

16. As per claim 34, Liu teaches the retractable cover being a sliding retractable cover, wherein the retractable sliding cover when retracted exposes a connector and when not retracted covers the connector. Liu does not teach a flat ledge and the retractable sliding cover when retracted slides onto the flat ledge to accommodate the retractable sliding cover while permitting exposure of the connector sufficient to be connected to the socket.

Powell teaches a device with a flat ledge [60, FIG. 1] and a retractable sliding cover [14, FIG. 1], the retractable sliding cover when retracted slides onto the flat ledge to accommodate the retractable sliding cover while permitting exposure of a connector sufficient to be connected to a socket [FIGs. 9-12], the flat ledge isolating the connector from the retractable sliding cover [col. 4, lines 57-59].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the sliding retractable cover to slide on a flat ledge, as is suggested by Powell, in order to use the flat ledge to isolate the connector from the retractable sliding cover.

17. As per claims 35-36, MacHASP/Ban teaches a housing to accommodate the memory and the USB interface [See image of the portable memory device on MacHASP].

18. As per claims 37-38, Powell teaches the flat ledge having an overall thickness

less than an overall thickness of a housing [18, FIG. 1] and the flat ledge being attached to the connector at an end and to the housing or an interface at another end [FIGs. 9-12], and the cover having an overall interior opening of a thickness greater than the overall thickness of the flat ledge [FIGs. 9-12].

19. As per claim 39, Powell teaches the flat ledge comprising a spring or a groove [FIGs. 9, 11]; the cover, the housing, and the flat ledge having a rectangular cross-sectional shape [FIGs. 1-8 of Powell]; and MacHASP teaches the housing and the USB connector having a rectangular cross-sectional shape.

20. As per claim 40, Evidence I does not specifically teach the hole having an oval shape. Since a change in shape is generally recognized as being within the level of ordinary skill in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the hole of Evidence I to have an oval shape as an alternative shape to the shape of the hole of the portable memory device of Evidence I. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

21. Claim 33 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. (US 6,671,808) in view of Liu.

Abbott teaches a portable memory device [200, FIG. 1] for a USB-supporting data processing system [100, FIG. 1; col. 5, lines 12-14], the memory device comprising a USB connector [e.g. 602-606, FIG. 6H, FIG. 6I] to be connected to a USB port [130, FIG. 1] of the data processing system [col. 5, lines 12-14], an integrated circuit memory [214, FIG. 2A] to write/read data [col. 5, lines 64-67], a USB interface [210, FIG. 2A] coupled between the USB connector and the memory to interface the memory with the

Art Unit: 2182

data processing system [col. 5, lines 55-59], wherein the portable memory device comprising a hole [228, FIG. 2A] to accommodate a key ring [col. 5, lines 51-53].

Abbott does not teach an automatically retractable cover having a rectangular cross section to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system.

Liu teaches an automatically retractable cover to protect a connector of a plug from damage when the plug is not connected to a socket (see rejection of claim 1 above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate an automatically retractable cover on the portable memory device in order to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system, as Liu would have suggested to one skilled in the art.

Liu also teaches the automatically retractable cover having a circular cross section, and the plug having a circular shape - hence suggests to one skilled in the art to shape the automatically retractable cover in accordance with the shape of the plug.

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the automatically retractable cover to have a rectangular cross section because Liu would have suggested to one skilled in the art to shape the automatically retractable cover in accordance with the shape of the portable memory device and the portable memory device has a rectangular shape, and also because a change in shape is generally recognized as being within the level of ordinary skill in the

art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

22. Claims 34-40 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. in view of Liu and further in view of Powell et al..

23. As per claim 34, Liu teaches the retractable cover being a sliding retractable cover, wherein the retractable sliding cover when retracted exposes a connector and when not retracted covers the connector. Liu does not teach a flat ledge and the retractable sliding cover when retracted slides onto the flat ledge to accommodate the retractable sliding cover while permitting exposure of the connector sufficient to be connected to the socket.

Powell teaches a device with a flat ledge [60, FIG. 1] and a retractable sliding cover [14, FIG. 1], the retractable sliding cover when retracted slides onto the flat ledge to accommodate the retractable sliding cover while permitting exposure of a connector sufficient to be connected to a socket [FIGs. 9-12], the flat ledge isolating the connector from the retractable sliding cover [col. 4, lines 57-59].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the sliding retractable cover to slide on a flat ledge, as is suggested by Powell, in order to use the flat ledge to isolate the connector from the retractable sliding cover.

24. As per claims 35-36, Abbott teaches a housing [200, FIG. 6J] to accommodate the memory and the USB interface [FIG. 2A].

25. As per claims 37-38, Powell teaches the flat ledge having an overall thickness less than an overall thickness of a housing [18, FIG. 1] and the flat ledge being attached

to the connector at an end and to the housing or an interface at another end [FIGs. 9-12], and the cover having an overall interior opening of a thickness greater than the overall thickness of the flat ledge [FIGs. 9-12].

26. As per claim 39, Powell teaches the flat ledge comprising a spring or a groove [FIGs. 9, 11]; the cover, the housing, and the flat ledge having a rectangular cross-sectional shape [FIGs. 1-8 of Powell]; and Abbott teaches the housing and the USB connector having a rectangular cross-sectional shape.

27. As per claim 40, Abbott teaches the hole having an oval shape [228, FIG. 2A].

Double Patenting

28. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical; but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

29. Claims 1, 24, 33-42 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 21, 26-28, 47-49, 51-56 of copending Application No. 11/410,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 1 and 24, 33-42 of the current application can be mapped out with claims 21, 26-28, 47-49, 51-56 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30. Claims 2, 4-8, 21-23, 25-28, 31-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21, 26-28 of copending Application No. 11/410,105 in view of Miller, MacHASP, and/or Ban. See teachings of Miller, MacHASP and Ban above.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

31. Applicant's arguments filed January 18, 2007 with respect to the rejected claims have been fully considered but they are not persuasive, and applicant's arguments with respect to the new claims are moot in view of the new grounds of rejections.

32. Applicant argues that MacHASP marked "Evidence 2" does not contain any publication date, and therefore does not qualify as citable art. The argument is not persuasive because the Information Disclosure Statement filed March 28, 2006 by applicant indicates that the reference was published on October 1998 - see 4th reference from the bottom of page 13, hence applicant already establishing the date of

the publication being October 1998.

33. Applicant argues that because MachASP does not teach the presence of any cover to protect the USB connector, the motivation to provide a cover must have come from applicant's specification, hence adding a cover amounting to impermissible use of hindsight reconstruction.

The argument is not persuasive because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, providing a cover for a connector is within the level of ordinary skill at the time the claimed invention was made, hence does not include knowledge gleaned from applicant's disclosure.

The argument is also not persuasive because Liu teaches a connector cover of an electrical plug for protecting the connector of the electrical plug from being damaged, the connector cover sliding automatically backward upon insertion of an electrical plug into a socket to allow the connector to be engaged into the socket. Liu would have suggested to one of ordinary skill in the art to provide a connector cover in order to protect a connector from being damaged.

34. Applicant argues that reliance on Liu for an electrical plug cover is improper because of the use of impermissible hindsight to assert the missing suggestion to

provide a protective cover.

The argument is not persuasive because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, providing a cover for a connector is within the level of ordinary skill at the time the claimed invention was made, hence does not include knowledge gleaned from applicant's disclosure.

35. Applicant argues that that reliance on Liu for an electrical plug cover is improper because Liu is non-analogous art, as Liu is directed to covering the prongs of an electrical plug attached to a powered device - typically done to prevent shock at the 110V or 220V potentially lethal voltage of socket powered electrical device.

The argument is not persuasive because Liu is directed to protecting an electrical connector with a connector cover to prevent the connector from being damaged. Since the claimed invention is also directed to protecting an electrical connector with a connected cover, Liu is considered as analogous art.

In addition, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

Art Unit: 2182

(Fed. Cir. 1992). In this case, protecting an electrical connector with a connector cover is at least reasonably pertinent to the particular problem with which applicant was concerned, hence it is proper to rely on Liu as a basis for the rejection of the claimed invention - even if Liu is non-analogous art (note that the examiner does not agree that Liu is non-analogous art).

36. Applicant argues that that reliance on Liu for an electrical plug cover is improper because the combination does not yield the claimed invention because the cover of Liu would not be suitable for a USB device - because the cover of Liu is of a circular shape and there is no suggestion in MachASP or Liu to modify the cover of Liu to fit a USB device.

The argument is not persuasive because the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Liu would have suggested to one skilled in the art to provide a connector cover in order to protect the connector from being damaged.

37. Applicant argues that neither Miller nor Crisan suggest the use of a retractable cover as recited in the claims, and Liu does not correct that deficiency for the reasons already noted. The argument is not persuasive because Liu was shown above to be proper prior art for the retractable cover.

Art Unit: 2182

38. Applicant argues that the provisional double patenting rejection is premature and should be withdrawn because the co-pending application (11/410,105) has yet to issue. The argument is not persuasive because the double patenting rejection needs to be made any time conflicting claims exist. The double patenting rejection is therefore not premature, and is not withdrawn.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ellison (US 6,062,881) teaches a plug with a retractable connector cover.

Belleci (US 5,518,411) teaches a plug with a retractable prong shield.

A car lighter plug teaches a retractable cover for shielding a connector when not connected to the car lighter socket, and exposing the connector when the plug is pushed into the socket for connection to the lighter circuit.

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2182

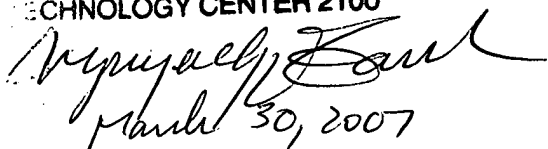
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TQN
March 30, 2007

TANH Q NGUYEN
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

March 30, 2007